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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chatam International Incorporated

Serial No. 76/138,531

Paul M. Lewis of Charles Jacquin et Cie., Inc. for Chatam International Incorporated.

Linda M. King, Trademark Examining Attorney, Law Office 101 (Angela Wilson, Acting Managing Attorney).

Before Hohein, Chapman, and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 29, 2000, Chatam International Incorporated (a Delaware corporation) filed an application to register the mark JOSE GASPAR GOLD on the Principal Register for "tequila" in International Class 33. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. In response to a requirement of the Examining Attorney, applicant stated

the following: "The name 'JOSE GASPAR' is not the name of any known living individual."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if used in connection with its identified goods, would so resemble the mark GASPAR'S ALE, which is registered for "beer or ale" in International Class 32,¹ as to be likely to cause confusion, or to cause mistake, or to deceive.²

When the refusal was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have briefed the issue before us, and an oral hearing was held on March 11, 2003.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling*

¹ Registration No. 2,063,790, issued on the Principal Register on May 20, 1997 to Bay Brewing Company (a Florida corporation), who subsequently assigned the registration to Ybor City Brewing Company (a Florida general partnership). Registrant disclaimed the word "ale." The claimed date of first use is January 31, 1995.

² The Examining Attorney had originally refused registration based on two cited registrations, both owned by the same registrant and the same assignee. In her brief, she withdrew the refusal to register based on Registration No. 2,088,953, issued August 19, 1997 for the mark GASPAR'S ALE LIMITED RELEASE YBOR PRIVATE STOCK and design for "beer or ale."

Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Turning to a consideration of the respective goods, applicant argues that the involved goods "are non-competing, being in separate classes and with such distinctiveness as to make them non-related"; but applicant further contends that "whether or not they are related is irrelevant" in view of the dissimilarities of the marks. (Brief, p. 6.)

The Examining Attorney contends that the goods are closely related; that the evidence of record establishes that tequila and beer or ale may be produced by the same entities and are marketed in the same channels of trade, and are encountered by the same consumers. In support thereof, the Examining Attorney referred to several published decisions involving the issue of likelihood of

confusion with respect to various alcoholic beverages;³ and she made of record copies of three third-party registrations, which issued on the basis of use in commerce, to demonstrate the close relationship between "tequila" and "beer or ale" by showing that a single entity has registered a single mark for identified goods including both distilled liquor and beer.⁴

Third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nevertheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

³ See e.g., *In re Sauerkraut Franz Sailor*, 23 USPQ2d 1719 (TTAB 1992); *Somerset Distilling Inc. v. Speymalt Whisky Distributors Ltd.*, 14 USPQ2d 1539 (TTAB 1989); *In re Leslie Hennessy, Jr.*, 226 USPQ 274 (TTAB 1985); and *United Rum Merchants Limited v. Fergal, Inc.*, 216 USPQ 217 (TTAB 1982).

⁴ Registration No. 2,326,965 includes "beer" and "tequila and liqueurs made with tequila"; Registration No. 2,350,261 includes "beer" and "distilled liquor, liqueurs and spirits"; and Registration No. 2,304,424 includes "beer, ale and porter" and "liquor and distilled spirits".

It is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from or are associated with the same source or that there is an association or connection between the producers of the respective goods. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001); and *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992).

Based on the record before us, we readily conclude that applicant's goods ("tequila") and the cited registrant's goods ("beer or ale") are closely related in a commercial sense. See *In re Majestic Distilling Company, Inc.*, supra, 65 USPQ2d at 1204, wherein the Court stated that "malt liquor and tequila are similar by virtue of the fact that both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers" and the Court pointed out that "Majestic has not demonstrated that consumers distinguish alcoholic beverages by manufacturer rather than by brand name."

Regarding the respective trade channels and purchasers of these goods, applicant argues that tequila is a distilled spirit sold through the distribution channels for such goods, whereas beer and ale are sold in separate distribution channels; and that even if sold in a single store, spirits and beer are grouped separately therein.⁵

Applicant's speculation that the goods are sold in different trade channels is irrelevant because the goods are identified with no restrictions as to trade channels or purchasers in either the application or the registration. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, the Board must consider that the parties' respective goods could be offered and sold to the same class of purchasers (general public) through all normal channels of trade (e.g., liquor stores, bars). See

⁵ In its reply brief, applicant stated the following:

Notice can also be taken that in most States, the channels of distribution of spirits and beers are separate, so separate, in fact, that they are sold in different stores. Further, even in those States that may permit sales of spirits and beers in a single store, the spirits are grouped together for sale and the beers are separately grouped for sale.

To whatever extent, if any, applicant is requesting that the Board take judicial notice of the purported facts in the above-quoted statements, we decline to do so. See Fed. R. Evid. 201; and TBMP §712.01.

Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

Moreover, we note that these are relatively inexpensive products. There is no evidence of whether these goods are purchased on impulse or with some degree of care.

We turn next to consideration of the similarities or dissimilarities of the marks. Clearly there are some differences in the marks--the cited registrant's mark consists of the words GASPAR'S ALE, while applicant's mark is JOSE GASPAR GOLD.

Applicant contends that the marks are distinct in sound, meaning, connotation and overall commercial impression; that the Examining Attorney improperly dissected the marks and focused only on the terms "GASPAR'S" and "GASPAR" respectively; that the dominant portion of applicant's mark is "JOSE GASPAR"; that applicant's mark connotes a Latino or Hispanic character associated with the goods (tequila -- which, according to the dictionary definition submitted by applicant, is a strong liquor made in Mexico from the Agave plant), while GASPAR'S ALE because it is used on ale creates an impression "most strongly associated with Anglo-Saxon or

Germanic countries, especially England" (applicant's September 25, 2001 response, p. 3); that the term "ALE" in registrant's mark is solely descriptive and unprotectable, but in applicant's mark the additional word "JOSE" communicates the Hispanic connotation and the word "GOLD" connotes premium quality of the product; and that when properly considered as a whole, there is no likelihood of confusion between the marks. Applicant submitted in support of its contentions dictionary definitions of the words "ale" and "tequila."

The Examining Attorney acknowledges that the marks must be compared in their entireties, but argues that:

Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. [Citations omitted] Due to the descriptiveness of the term ALE for beer and ale and the weakness of the term GOLD for tequila, the relevant comparison of the respective marks is between the highly similar terms JOSE GASPAR and GASPAR['S], with the term GASPAR being the dominant feature of the respective marks.

Specifically, she contends that the dominant term in both marks is GASPAR (with such term in registrant's mark appearing in the possessive form); that the terms "JOSE GASPAR" in applicant's mark certainly connote the name of

an individual (even if a fictitious person); that the term GASPAR is distinctive for the goods, being a strong term "inherently and on the Register" (brief, unnumbered p. 5); that consumers will not remember the differences in the marks and may well refer to both applicant's and registrant's goods by the word "GASPAR"; and that consumers are not likely to view "ale" as a product of Europe because ale has become quite common in the United States. In support of her latter argument the Examining Attorney submitted several third-party registrations, all of which include "ale" in the identification of goods, and all but one of which issued as registrations to United States entities. (The only one not issued to a U.S. entity was issued to a Canadian corporation.)

It is well settled that marks must be considered and compared in their entirety, not dissected or split into component parts so that parts are compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master*

Manufacturing Co., 667 F.2d 1005, 212 USPQ 233 (CCPA 1981).

See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

Moreover, under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corp., 206 USPQ 255 (TTAB 1980).

There are obvious differences between the registered mark GASPAR'S ALE, and applicant's mark JOSE GASPAR GOLD. Specifically, the cited registered mark consists of the word GASPAR'S in the possessive form, and includes the generic word ALE, whereas applicant's three-word mark consists of the first name JOSE, the word or name GASPAR, and the suggestive or descriptive word GOLD. (Applicant acknowledges that the term GOLD indicates "premium quality and value." Reply brief, p. 3.) The fact that the registered mark appears in the possessive form adds to the connotation of the term GASPAR'S as that of a name, and indicating that the beer and ale is made by GASPAR or the recipe for the beer and ale came from GASPAR. In

applicant's mark, the addition of a first name JOSE simply emphasizes the fact that GASPARG connotes a person's name. That is, JOSE GASPARG sounds like and connotes a person's full name -- first name and last name. JOSE GASPARG also connotes a Latino or Hispanic connection, which is especially true when considered in relation to applicant's goods -- tequila (a liquor made in Mexico). However, these features, rather than distinguishing the marks, may likely lead purchasers to assume that the GASPARG'S ALE line of beer and ale has now expanded and offers a line of tequila under the mark JOSE GASPARG GOLD, a revised version of the GASPARG'S ALE mark, specifically intended to connote a Hispanic theme, and/or that a specific member of the GASPARG family producing beer and ale has tried his/her hand at distilling tequila.

Moreover, applicant has not submitted evidence that the mark GASPARG'S ALE is weak⁶ in the relevant field of alcoholic beverages.⁷

⁶ We specifically note that the cited registered mark is on the Principal Register with no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b).

⁷ We are aware that in applicant's September 25, 2001 response to the first Office action, it argued with regard to the Examining Attorney's reference to a prior filed application (Serial No. 76/062,290 for the mark JOSE for "non-alcoholic mixes to be used with tequila" and "tequila" owned by Tequila Cuervo La Rojena, S.A. de C.V.) that the reference should be withdrawn for several reasons, including the existence of other registrations which

Applicant's addition of the first name "JOSE" and the highly suggestive word "GOLD" does not serve to distinguish applicant's mark from that of the registrant. That is, purchasers are unlikely to remember the specific differences between the marks due to the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. Purchasers seeing the marks at separate times may not recall these differences between the marks. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Purchasers of these general consumer goods will not go through a complicated thought process to define and

include the word JOSE. Specifically, applicant made reference to its own Registration No. 860,664 for the mark JOSE CORTEZ for "tequila," Registration No. 740,133 for the mark JOSE PEMARTIN for "wines," and Registration No. 1,816,039 for the mark DON JOSE for, *inter alia*, "fruit drinks." Applicant did not submit copies of these registrations, but rather, simply made reference thereto in its argument. See *In re Duofold, Inc.* 184 USPQ 638 (TTAB 1974). The Examining Attorney withdrew the reference to the prior filed application, and applicant did not reiterate this argument in its brief or its reply brief with regard to the cited registrations. Even if the argument had been reiterated by applicant, it would not be persuasive of a different result herein, for these registrations would be probative, if at all, only of the frequency with which JOSE appears in registered marks for alcoholic (and other) beverages, not the frequency with which GASPAR or GASPAR'S appears in registered marks. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

distinguish each word in both of the marks GASPAR'S ALE and JOSE GASPAR GOLD. Further, the terms "ale" and "gold," as used in registrant's and applicant's respective marks, and considered in the context of the involved goods (beer and ale vis-a-vis tequila), do not add anything particularly unique or distinguishing to consumers' perception of the marks.

Applicant strongly urges that the case of *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992), requires reversal of the refusal in the case now before the Board. Specifically, applicant contends that the Examining Attorney erred by "improperly discounting from and giving no weight to the words 'JOSE' and 'GOLD' in Appellant's mark and similarly discounting from and dismissing with no weight the word 'ALE' from the remaining cited mark." (Reply Brief, p. 4.) However, in the application now before the Board, the cited registered mark consists of the word GASPAR'S and the generic word "ale" which has rightfully been disclaimed by registrant, while applicant has added a first name, making it clear this is an individual's name, and the highly suggestive or descriptive word "gold" referring to tequila and the quality thereof. Importantly, the Court explained in the Hearst case at 25 USPQ2d 1239 that "the weight given to the respective words

is not entirely free of subjectivity... ." In any event, we disagree that the Hearst case requires a different result herein as we have given each element of applicant's mark appropriate weight, and of course, we have ultimately considered the similarities/dissimilarities of the marks in their entirety.

We find that applicant's mark JOSE GASPAR GOLD and registrant's mark GASPAR'S ALE, when considered in their entirety, although obviously not identical, are similar in sound, appearance, connotation and commercial impression. See *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999). The contemporaneous use of these marks, in connection with these closely related goods, would be likely to cause confusion as to the source or sponsorship of such goods. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *In re Dixie Restaurants Inc.*, supra.

To the extent we have any doubt on the question of likelihood of confusion, it must be resolved against applicant as the newcomer, because the newcomer has the opportunity of avoiding confusion and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

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Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.